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Motorcycle Auto

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,887	04/20/2001	Kevin R. Willett	85939.000193	4285

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MAY 28 2002

EXAMINER

UHLIR, NIKOLAS J

ART UNIT PAPER NUMBER

1773

DATE MAILED: 05/22/2002 ✓

Final Rejection: 8/22/02

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED

MAY 28 2002

Office Action Summary

Application No.

09/839,887

Applicant(s)

WILLETT, KEVIN R.

Examiner

Nikolas J. Uhler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 23, 24, 26 and 33-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 23-24, 26, and 33-65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20, 23-24, 26, and 33-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As amended, claims 1-20, 23-24, 26, and 33-65 require an automotive weatherseal, comprising a resilient polymeric body, a metal reinforcing member, and either simply a "powder coating" or a "heat fusible" powder coating on a portion of the metal reinforcing member and the resilient polymeric body. These claims do not require that the powder coating be fused/melted on the surface of the polymeric body or the metal reinforcing member, thereby forming a contiguous layer. The applicant is specifically referred to page 7, lines 13-20 of the specification, wherein the applicant discloses "The surface film 60 is a powder coating applied to the body 20 **and subsequently melted** to form a **contiguous and preferably continuous** layer. Thus, the surface film 60 is a **colliquefied powder** coating forming a **contiguous layer**. **Contiguous** includes a **single piece connected film**, wherein **continuous** defines an **uninterrupted contiguous film**. Thus, the present surface film is a **single piece**, or sheet of material, **as opposed to a plurality of discrete, unconnected sections**."

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Thus, page 7, lines 13-20 of the specification as written appears to only support a contiguous/continuous layer, not a "plurality of discrete unconnected sections," as would be provided by a powder coating that is not melted or fused. Thus, these claims present new matter that is not supported by the original claims or specification. Further, claims 46, 52, 58, and 63 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added Claims 46, 52, 58, and 63 require that the weatherseal comprise a trim portion and a sealing portion, wherein one of the trim portion and sealing portion has a lower density than the remaining one of the trim portion and the sealing portion. Neither the original specification or the original claims disclose that one of the trim portion or sealing portion can have a lower density than the remaining portion. Thus, this limitation is new matter.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-7, 9-10, 12-14, 16-20, 23-24, 26, and 33-65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ford et al. (US5545448) as evidenced by Cook (US6024906).

6. For the purpose of this examination the examiner is interpreting the terms "powder coating," and "heat fusible powder coating" to mean a powder coating which is melted to form a contiguous and preferably continuous layer, as is commensurate in scope with the applicants specification (see page 7, lines 13-28 of the specification).

7. The limitation that the coating of the invention is a "powder coating" or "a heat fusible powder coating", as required by claims 1-20, 23-24, 26, and 33-65 and interpreted above is a process limitation and does not appear to be further limiting in so far as the structure of the finished product is concerned. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

8. Ford et al. teaches a colored extruded strip for use as a weather seal on a motor vehicle (Column 1, lines 41-46). This weather seal is comprises a composite door seal and static edge trim or carrier portion as shown in figure 1 (column 1, lines 20-23). The seal portion is extruded from elastomeric ethylene-propylene-diene polymers (EPDM), which are known thermosetting materials (Column 2 lines 20-24). EPDM, as evidenced

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by Cook, is inherently resilient (Cook column 4, lines 63-66, and column 5, lines 42-45). Ford et al. teaches that the static edge trim portion is formed of a colored plastic material (column 2, lines 28-30). This includes thermoplastics. Although Ford et al. does not specifically teach that one of the trim portion and sealing portion of the weatherseal has a lower density than the other portion, the examiner takes the position that this limitation is necessarily met because the weatherseal parts taught by Ford et al. are formed from two different polymeric materials. Thus, one of the static trim portion or the sealing portion of the weatherseal will necessarily have a lower density than the remaining part. In addition, the static trim portion can incorporate a metallic formed carrier 7, which upon inspection of the drawings is substantially u-shaped (Column 2, lines 24-25). This metallic carrier is completely covered by the polymeric body, as shown in Figure 1. The examiner takes the position that a completely covered metal reinforcing member encompasses a metal reinforcing member that is partially covered. Thus, the limitations of claim 4 are met. Ford et al. teaches that the whole outer surface area of the combination seal and edge trim is covered with a colored spray coating (column 3, lines 30-33). This coating is a polyurethane material formulated to provide good adhesion and flexibility (column 3 lines 26-30). It is well known that polyurethane's can be either thermosetting or thermoplastic polymers. In addition, this coating is available in different levels of glossiness (Column 3 lines 54-56). This coating is formulated to provide excellent adhesion to both substrates (column 3, lines 30-33). This coated edge/seal trim article is described for use as a sealing device for a traditional corner joint in a vehicle door (column 3 line 66, column 4 line 3).

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9. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cook (US6024906).

10. For the purpose of this examination the examiner is interpreting the terms "powder coating," and "heat fusible powder coating" to mean a powder coating which is melted to form a contiguous and preferably continuous layer, as is commensurate in scope with the applicants specification (see page 7, lines 13-28 of the specification).

The limitation that the coating of the invention is a "powder coating" or "a heat fusible powder coating", as required by claims 1-20, 23-24, 26, and 33-65 and interpreted above is a product-by-process limitation and does not appear to be further limiting in so far as the structure of the product is concerned. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

11. Cook teaches a composite extrusion which is suitable for use as a window channel or seal in the automotive industry (Column 3 lines 15-20). The main body of this composite extrusion comprises EPDM rubber (Column 4, lines 63-67). EPDM rubber is an inherently resilient material (column 4, lines 63-66, and column 5, lines 42-45). A layer of thermoplastics material, ideally EPDM modified polypropylene, is extruded onto several surface areas of the main body (Column 5, lines 8-17). Cook teaches that the

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EPDM rubber is a thermoset material, whereas polypropylene is a thermoplastic material (Column 4 lines 16-36).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 3, 5, 8, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford et al. as evidenced by Cook (US6024906), in view of Chihara et al. (US5115007).

14. For the purpose of this examination the examiner is interpreting the terms "powder coating," and "heat fusible powder coating" to mean a powder coating which is melted to form a contiguous and preferably continuous layer, as is commensurate in scope with the applicants specification (see page 7, lines 13-28 of the specification).

15. The limitation that the coating of the invention is a "powder coating" or "a heat fusible powder coating", as required by claims 1-20, 23-24, 26, and 33-65 is a process limitation and does not appear to be further limiting in so far as the structure of the finished product is concerned. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

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different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP § 2113.

16. Ford et al. teaches all of the limitations of claims 1, 3, 5, 8, 10, 15 as stated above, except for those limitations listed below.

Ford et al. does not teach an automotive weather seal which has a surface film coating that is less than .2mm thick, specifically .05mm-.2mm thick (2-8 mils) or less.

Chihara teaches an abrasion resistant polyurethane blend which is suitable for use as a uniform coating on an automotive glass run channel comprised of EPDM rubber (Column 2 lines 12-29). This compound can be applied to the EPDM substrate without a primer coating and is weather resistant (column 7, lines 8-50). At a coating thickness of .2 mils, the coating has an abrasion resistance of 25,500 cycles. At a thickness of .45 mils (11.5 microns), the coating has an abrasion resistance of 29,500 cycles (table 3). At a thickness of .6 mils (15.5 microns), the coating has an abrasion resistance of 30,000 cycles (Table 3). Finally, at a thickness of 1.15 mils (29 microns), the coating has an abrasion resistance of 34,000 cycles (column 11, lines 32-35). Thus it is logical to assume that abrasion resistance is proportional to film thickness, wherein thicker films exhibit more resistance to abrasion and thinner films exhibit less resistance. Although Chihara does not explicitly teach a coating thickness between 2-8 mils, there is no statement directly precluding the use of a coating of this thickness. Therefore it is logical to believe that a coating thickness between 2-8 mils would show exceptionally high abrasion resistance and would be suitable for applications where a

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high durability coating was desired. Thus, the examiner takes the position that coating thickness is a results effective variable

Therefore it would have been obvious to one with skill in the art at the time the invention was made to substitute up to a 2-8 mil thick coating of the polyurethane composition described by Chihara for the polyurethane coating on the weather seal taught by Ford et al.

One would have been motivated to make this substitution due to the exceptionally high wear resistance one would expect to see as a result.

Response to Arguments

17. Applicant's arguments with respect to claims 1-20, 23-24, 26, and 33-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhler whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

nju

nju
May 20, 2002

Paul Thibodeau

Paul Thibodeau
Supervisory Patent Examiner
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